

Kenneth S. Kump

S/N: 10/711,762

REMARKS

Claims 1-33 are pending in the present application. In the Office Action mailed September 8, 2005, the Examiner rejected claims 1-10, 17-18, and 20-23 under 35 U.S.C. §103(a) as being unpatentable over Yamamoto (US Pub. 2004/0114725) in view of Dvorkis et al. (US Pub. 2003/0136844).

Applicant appreciates the indication that claims 11-16 and 19 are allowable.

In the rejection of claims 1-10, 17-18 and 20-23, the Examiner relied upon a combination Yamamoto and Dvorkis et al. In setting forth the obviousness rejection, the Examiner concluded that "it would have been obvious to one of ordinary skill in the art at the time of the invention to adapt the x-ray detector of Yamamoto with the gravitational sensor as taught by Dvorkis, since the device of Dvorkis would indicate/inform proper working condition of the detector or sophisticated electronic device (paragraph [0102])." OFFICE ACTION, September 8, 2005, pp. 2-3. In other words, the Examiner believes that claims 1-10, 17-18 and 20-23 are unpatentable because Dvorkis discloses an electronic accelerometer and Yamamoto discloses an x-ray detector. However, the motivation to combine the elements must be provided by the references themselves. That is, the motivation cannot be provided by the Examiner through the application of impermissible hindsight based on unrelated references found in a keyword search.

The burden of establishing a prima facie case of obviousness falls on the Examiner. MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a prima facie case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). That is, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01. "The fact that references can be combined or modified is not sufficient to establish prima facie obviousness." *Id.* When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest

Kenneth S. Kump

S/N: 10/711,762

the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Applicant believes that a *prima facie* case of obviousness has not been established and one cannot be made based on the art of record because there is no motivation to combine the references and the art of record fails to teach each and every element of the claimed invention.

Applying the above standards, it is clear that the Examiner has failed to establish a *prima facie* case of obviousness for rejecting claims 1-10, 17-18, and 20-23 under 35 U.S.C. §103(a). Specifically, the Examiner has failed to establish that one skilled in the art of x-ray detectors would be motivated to incorporate an electronic accelerometer into such an x-ray detector because of Dvorkis' teaching of the barcode reader with an integrated accelerometer. The Examiner has reached such a conclusion based on the premise that Dvorkis pertains to a sophisticated electronic device and, since an x-ray detector is a sophisticated device, one skilled in the art would be motivated to combine the teachings and arrive at the claimed invention from those teachings.

While Applicant agrees that Dvorkis discloses that the benefits of an electronic accelerometer may be extended to other hand-held computerized devices, such as laptop computers and computer peripherals, there is no teaching in the reference whatsoever that the incorporation of an electronic accelerometer may extend to the highly specialized area of x-ray detectors. In fact, in the context of the Dvorkis disclosure, the reference is shown to be particularly applicable for hand-held optical scanners, such as those used for barcode reading. One skilled in the art of x-ray detectors would clearly recognize that the distinctions, differences, and concerns with respect to flat panel x-ray detector construction and design are substantially and significantly different from those encountered by those in the hand-held optical scanner, laptop, and related arts. Moreover, based on the disclosure of Dvorkis, one skilled in the art would readily recognize that the suggested types of goods to which the teachings of Dvorkis may be applicable pertain to those hand-held devices that are in operation when being hand-held, such as, a barcode reader and a laptop computer. In contrast, one skilled in the art would readily recognize that a flat panel x-ray detector is not a device that is hand-held during operation thereof. In this regard, one skilled in the art would readily recognize that the class of goods suggested by Dvorkis to which its invention and the benefits thereof may pertain does not include x-ray detectors. As such, contrary to the Examiner's conclusion, there is not a motivation within the references to support the §103 rejection preferred by the Examiner.

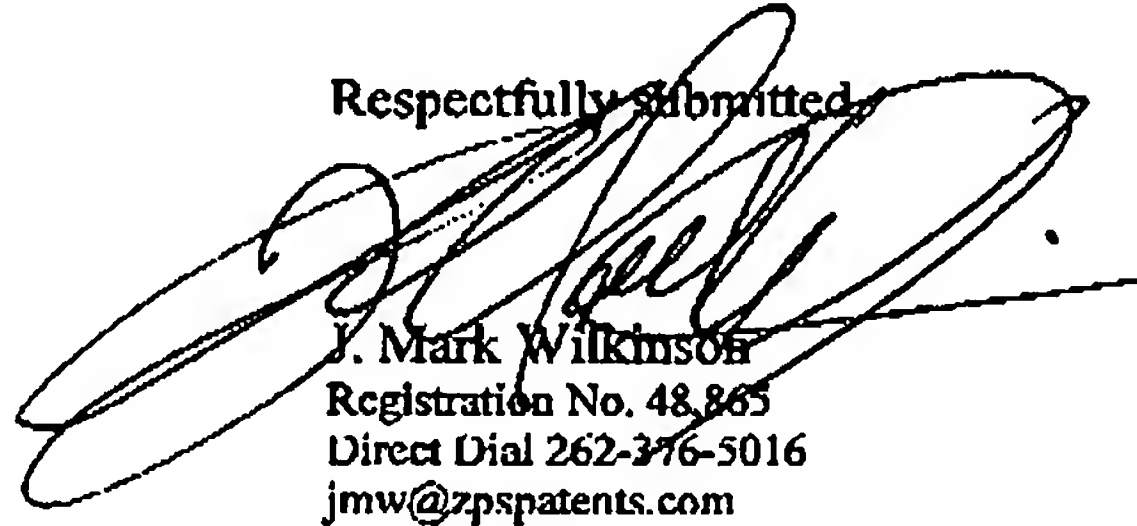
Kenneth S. Kump

S/N: 10/711,762

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-33.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully Submitted,



J. Mark Wilkinson
Registration No. 48,865
Direct Dial 262-376-5016
jmw@zpspatents.com

Dated: October 17, 2005
Attorney Docket No.: GEMS8081.240

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170